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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,717	11/11/2003	Claus Harder	117163.00095	7255

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EXAMINER	
TYSON, MELANIE RUANO	
ART UNIT	**PAPER NUMBER**
3773	

NOTIFICATION DATE	DELIVERY MODE
02/07/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/706,717	HARDER ET AL.	
	Examiner	Art Unit	
	MELANIE TYSON	3773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 November 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-37* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This action is in response to applicant's amendment received on 26 November 2007.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1-17 and 19-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu et al. (6,979,347 B1). Wu discloses an endoprosthesis (see entire document) having a carrier structure of metallic material, wherein the metallic material comprises a magnesium alloy (for example, see column 4, lines 30-35). It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a magnesium alloy of the composition claimed, since such magnesium alloys are well known (for example, see Unsworth's patent 4,401,621; discloses magnetic alloys of such composition have good tensile properties at both ambient and elevated temperatures, and are resistant to creep while having an adequate ductility).

Furthermore, the functional language of claims 7 and 25-29 has been carefully considered, but deemed not to impose any structural limitations on the claims to make them patentably distinguishable over Wu's device, which is capable of performing the function as claimed.

Wu discloses a self-expanding or balloon expandable stent (for example, see column 3, lines 41-55) produced by cutting (for example, see column 3, lines 32-35), for use in any biological or physiological lumen (for example, column 3, lines 56-65), formed by a plurality of legs (22) and connecting elements (24), carrying an active substance (for example, see column 2, lines 1-6), and coated with a drug (for example, see column 1, lines 39-43). The legs (22) have the same suitable width (W1) and the same suitable thickness (T; column 4, lines 16-29). Since the grooves formed on the plurality of legs (22) preferably have depths less than 50% of the thickness (T) of the plurality of legs (22; column 5, lines 9-10), the ratio of largest to smallest cross-sectional area and diameter of the plurality of legs is smaller or less than 2.

4. Claims 18, 36, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu et al. in view of Richter (Patent No. 6,676,697 B1). Wu discloses a device as described above, where the plurality of legs (22) form rings that are connected via connecting legs (24; column 3, line 66 - column 4, line 4). However, Wu fails to disclose the connecting legs are of a smaller cross-sectional area than the plurality of legs. Richter discloses a stent having a plurality of members and connectors (Figure 1). Richter teaches that reducing the width of the connectors provides the device with greater flexibility (column 6, line 44 – column 7, line 5). Therefore, it would

have been obvious to one of ordinary skill in the art at the time the invention was made to construct the connecting legs of the device of Wu with a smaller cross-sectional area than the legs as taught by Richter in order to provide the device with greater flexibility, which in turn allows the device to accommodate the curvature of vessels.

Response to Arguments

5. Applicant's arguments filed 26 November 2007 have been fully considered but they are not persuasive. Applicant argues primarily that Unsworth fails to teach that the magnesium alloy disclosed may be useful in stents. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize such a well known magnesium alloy, as evidenced by Unsworth, in Wu's stent, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice.

Furthermore, it is well within the general knowledge of one having ordinary skill in the art to choose from a finite number of identified, predictable solutions, with a reasonable expectation of success. Wu discloses utilizing magnesium alloys for fabricating stents. Unsworth suggests a magnesium alloy encompassing the composition claimed. Unsworth teaches that magnesium alloys comprising such a composition are capable of giving good tensile properties over a wide range of temperatures, including ambient and elevated temperatures, and high resistance to creep while retaining satisfactory ductility, making them highly suitable for engineering applications (for example, see column 2, lines 13-45). Therefore, it would have been

obvious to one having ordinary skill in the art at the time the invention was made to try the well known magnesium alloy, as evidenced by Unsworth, in Wu's stent. Doing so would provide Wu's stent with the mechanical advantages described above.

With respect to the applicant's argument that neither Wu nor Unsworth teach or suggest the use of such an alloy would provide advantageous properties such as prevention of restenosis from sustained tissue growth prevention, a lack of inflammatory effect, minimize inflammation, minimize restenosis, decomposition products which have positive effect and no negative effect, and torsional strength, it is well settled that a patent cannot be granted for an applicant's discovery of a result, even though it may be unexpectedly good, which would flow logically from the teaching of the prior art.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELANIE TYSON whose telephone number is (571)272-9062. The examiner can normally be reached on Monday through Friday 9-5:30 (max flex).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Melanie Tyson /MT
January 30, 2008

/Darwin Erezo/
DARWIN EREZO
PRIMARY EXAMINER